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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,129	11/15/2000	Joseph T. Strupczewski	2489.0028-11	8800

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 08/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/712,129

Applicant(s)
STRUPCZEWSKI et al.

Examiner
Brenda Coleman

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1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 19, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-75 and 77-147 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 67-75, 77, 78, 80, and 82-147 is/are rejected.
- 7) ☒ Claim(s) 2-66, 79, and 81 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claims 1-75 and 77-147 are pending in the application.

This action is in response to applicant's amendment filed June 19, 2002. Claims 1, 26, 52-59, 65, 66, 74, 77-86, 98, 114, 132 and 142 have been amended.

Response to Amendment

Applicant's arguments filed June 19, 2002 have been fully considered with the following effect:

1. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
2. With regards to the 35 U.S.C. § 112, first paragraph rejection of claims 78 and 82-86, the applicants' arguments have been fully considered but are not found persuasive. The applicants' stated that "the definition of R as alkanoyl may be found in the instant specification (disclosure of U.S. Pat. No. 5,364,866) at the bottom of column 24, seven lines up from the bottom". The definition of R in claim 78 is such that R is hydrogen, C₁-C₃ alkyl, C₁-C₃ alkoxy, hydroxyl, alkanoyl, Cl, F, Br, I, amino, C₁-C₃ mono or dialkyl amino, acylamino, -NO₂, -OCF₃, -CF₃, alkyl-C(=O)-, CF₃-C(=O)-, or -CH(OR₇)-alkyl which is not described in the specification within the **genus**. The definition of R in column 24 is part of a sub-genus of the formula, not the description of the genus of the formula. Claim 78 does not contain all the possible permutations for the other variables and thus results in compounds not embraced by claim 78. The variable R can be present

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more than once, i.e. m is 1, 2, or 3. The definition of R in column 24 is hydrogen, C₁-C₃ alkyl, C₁-C₃ alkoxy, hydroxyl, -COCF₃, C₁-C₆ alkanoyl, Cl, F, Br, I, **amino**, C₁-C₃ mono **or dialkyl** amino, **acylamino**, -NO₂, -CF₃, -OCF₃, **lower** alkyl-C(=O)-, or -CH(OR₇)-**lower** alkyl. Hence new matter exists when one of the R variables is amino or acylamino and the other is alkanoyl, etc. Additionally, alkanoyl in claim 78 is generic, thus based on the definition of alkanoyl in the specification this is taken to mean C₁-C₁₀ alkanoyl which is not within the definition of R in column 24.

Claims 78 and 82-86 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For reasons of record and stated above.

3. The applicants' amendment and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections of the last office action which are herein **withdrawn**.

4. With regards to the 35 U.S.C. § 102, anticipation rejection of claims 78 and 82-86, the applicants' arguments have been fully considered but are not found persuasive. The applicants' stated that "the definition of R as alkanoyl may be found on page 8, line 11 of Appln. No. 06/456,790, filed December 29, 1989" and that "claims 78 and 82-86 are entitled to a priority date of December 29, 1989, they can not be anticipated by Strupczewski, which was published on December 19, 1990". However, as pointed out in the response to applicants' remarks concerning

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the 35 U.S.C. § 112, first paragraph rejection, the definition of R where R is alkanoyl is not supported by the disclosure. Additionally, 06/456,790 was filed January 1, 1983 and is now Patent No. 4,451,348 and titled FUNCTIONAL ELECTRODE. Since there is no claim to U.S.S.N. 06/456,790 it is not seen how the definition of alkanoyl would be present.

Claims 78 and 82-86 are rejected under 35 U.S.C. 102(b) as being anticipated by Strupczewski et al., EP 402 644. For reasons of record and stated above.

In view of the amendment dated June 19, 2002, the following new grounds of rejection apply:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 67-75, 77, 80 and 82-147 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claims 1 (and claims dependent thereon) include a hyphen "-" in the moiety -CH₂-CH=CH-CH₂-CH₂- in line 14 of page 2 which does not appear in claim 1 of U.S. 5,364,866.

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- b) Claims 1 (and claims dependent thereon) are missing a circle in the phenyl ring which appears in claim 1 of U.S. 5,364,866. Instead of the double bonds which appear in the amendment.

§ 1.121 Manner of making amendments.

(a) Erasures, additions, insertions, or alterations of the Office file of papers and records must not be physically entered by the applicant. Amendments to the application (excluding the claims) are made by filing a paper (which should conform to § 1.52) directing or requesting that specified amendments be made. The exact word or words to be stricken out or inserted by said amendment must be specified and the precise point indicated where the deletion or insertion is to be made.

(b) Except as otherwise provided herein, a particular claim may be amended only by directions to cancel or by rewriting such claim with underlining below the word or words added and brackets around the word or words deleted. The rewriting of a claim in this form will be construed as directing the cancellation of the original claim; however, the original claim number followed by the parenthetical word "amended" must be used for the rewritten claim. If a previously rewritten claim is rewritten, underlining and bracketing will be applied in reference to the previously rewritten claim with the parenthetical expression "twice amended," "three times amended," etc., following the original claim number.

(c) A particular claim may be amended in the manner indicated for the application in paragraph (a) of this section to the extent of corrections in spelling, punctuation, and typographical errors. Additional amendments in this manner will be admitted provided the changes are limited to (1) deletions and/or (2) the addition of no more than five words in any one claim. Any amendment submitted with instructions to amend particular claims but failing to conform to the provisions of paragraphs (b) and (c) of this section may be considered nonresponsive and treated accordingly.

(d) Where underlining or brackets are intended to appear in the printed patent or are properly part of the claimed material and not intended as symbolic of changes in the particular claim, amendment by rewriting in accordance with paragraph (b) of this section shall be prohibited.

(e) In reissue applications, both the descriptive portion and the claims are to be amended by either (1) submitting a copy of a portion of the description or an entire claim with all matter to be deleted from the patent being placed between brackets and all matter to be added to the patent being underlined, or (2) indicating the **exact word** or words to be stricken out or inserted and the precise point where the deletion or insertion is to be made. Any word or words to be inserted must be underlined. See § 1.173.

(f) Proposed amendments presented in patents involved in reexamination proceedings must be presented in the form of a full copy of the text of: (1) Each claim which is amended and (2) each paragraph of the description which is amended. Matter deleted from the patent shall be placed between brackets and matter added shall be underlined. Copies of the printed claims from the patent may be used with any additions being indicated by carets and deleted material being placed between

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brackets. Claims must not be renumbered and the numbering of the claims added for reexamination must follow the number of the highest numbered patent claim. No amendment may enlarge the scope of the claims of the patent. No new matter may be introduced into the patent.

- c) Claims 1 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of R_3 which is not written in the form of a Markush group, "or" between the last two moieties is suggested.
- d) Claims 80 (and claims dependent thereon) recite the limitation "CH" in the formula. There is insufficient antecedent basis for this limitation in the claim.
- e) Claims 80 (and claims dependent thereon) are missing a circle in the phenyl ring which appears in claim 1 of U.S. 5,364,866. Instead of the double bonds which appear in the amendment.
- f) Claims 80 (and claims dependent thereon) recite the limitation "hydroxy and halogen" in the definition of Y. There is insufficient antecedent basis for this limitation in the claim.
- g) Claims 80 (and claims dependent thereon) recite the limitation " (R_1) " in the formula. There is insufficient antecedent basis for this limitation in the claim.
- h) Claims 80 (and claims dependent thereon) recite the limitation " R_{20} , R_{21} , or R_{22} , wherein: R_{20} is $-(CH_2)_n-$, where n is 2, 3, 4 or 5;where Z_1 is lower alkyl, -OH, lower alkoxy, -CF₃, -NO₂, -NH₂ or halogen" in the definition of R_1 . There is insufficient antecedent basis for this limitation in the claim.

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- i) Claims 80 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by second appearance of the definition of m.
- j) Claims 80 (and claims dependent thereon) recite the limitation "monoalkylaminocarbonyl, dialkylaminocarbonyl, formyl, -CH(OR⁷)-alkyl, -C(=W)-alkyl, -C(=W)-aryl, and -C(=W)-heteroaryl" in the definition of R. There is insufficient antecedent basis for this limitation in the claim.
- k) Claims 80 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the variable R⁷ which is not defined in the claim.
- l) Claims 80 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of R₇ since there is no variable R₇ in the claim.
- m) Claims 80 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of R₅ which is not written in the form of a Markush group, "or" between the last two moieties is suggested.
- n) Claims 80 (and claims dependent thereon) recite the limitation "lower dialkylamino" in the definition of R₅. There is insufficient antecedent basis for this limitation in the claim.
- o) Claims 80 (and claims dependent thereon) recite the limitation "W is CH₂ or CHR₈ or N-R₉" in the formula. There is insufficient antecedent basis for this limitation in the claim.

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- p) Claims 80 (and claims dependent thereon) recite the limitation " R_8 is lower alkyl; R_9 is hydroxy, lower alkoxy, or $-NHR_{10}$; and R_{10} is hydrogen, lower alkyl, C_1-C_3 acyl, aryl, $-C(=O)$ -aryl or $-C(=O)$ -heteroaryl, where aryl and heteroaryl are as defined above, and" in the formula. There is insufficient antecedent basis for this limitation in the claim.
- q) Claims 80 (and claims dependent thereon) is vague and indefinite in that it is not known what is meant by the "j" which appears in the third line on page 11.
- r) Claims 87 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of R_5 which is not written in the form of a Markush group, "or" between the last two moieties is suggested.
- s) Claims 104 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of R_5 which is not written in the form of a Markush group, "or" between the last two moieties is suggested.
- t) Claims 132 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of R_5 which is not written in the form of a Markush group, "or" between the last two moieties is suggested.

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Claim Objections

6. Claims 2-66, 79 and 81 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays and Tuesdays from 9:00 AM to 3:00 PM and from 5:30 PM to 7:30 PM and on Wednesday thru Friday from 9:00 AM to 6:00 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Brenda Coleman
Primary Examiner AU 1624
August 28, 2002